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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,923	03/01/2004	Nancy C. Frye	063293.0110	1435
5073	7590	05/02/2011	EXAMINER [REDACTED]	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			PATTERSON, MARIE D	
			ART UNIT [REDACTED]	PAPER NUMBER 3765
			NOTIFICATION DATE 05/02/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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BAKER BOTTS L.L.P.  
2001 ROSS AVENUE  
SUITE 600  
DALLAS TX 75201-2980

*In re* Application of:  
FRYE, NANCY C.  
Serial No.: 10/790,923  
Filed: March 1, 2004  
Docket: 063293.0110  
Title: SHOE AND LAST

: DECISION ON PETITION  
: TO WITHDRAW DRAWING  
: OBJECTION  
:

This is a decision on the petition filed on March 22, 2011 seeking reversal of the drawing objection under 37 CFR 1.83(a). The petition is being considered pursuant to 37 CFR 1.181. No fee is required.

The petition is **DISMISSED**.

In the petition, the petitioner requests a review of the examiner's objection to the drawings under 37 CFR § 1.83(a)<sup>1</sup>. The examiner objected to the drawing on the grounds that the claimed subject matter of claims 8, 9, 16 and 20 were not illustrated. In particular, the examiner required the applicant to illustrate the claimed "midsole(s)". Petitioner believes that the Replacement drawing to Fig. 14 is supported by the originally filed specification and overcome the Rule 83 drawing objection. The examiner disagrees because the Replacement drawing of Fig. 14 contains new matter not supported by the originally filed specification.

Discussion and Analysis

A review of the record indicates that the drawing objection and claim rejection are directed to the same issues. In the non-final Office action of April 21, 2011 rejection of

<sup>1</sup> § 1.83 Content of drawing. (a) The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings.

claims 1, 5-9, 11, 14-16 and 19-24 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The remainder rejection<sup>2</sup> has been reproduced below. The examiner cannot find support for these claim limitations. It is not clear how these limitations and structural arrangements were disclosed in the original specification or drawings. On Paragraph 8 of the non-final Office action of April 21, 2011, the examiner further states that page 22 of the specification is confusing and not clear as to how planar surfaces of a midsole would provide the claimed benefits of a negative heel configuration as stated. These passages do not provide clear basis for claiming a midsole or for addition of a midsole to the drawings. There is no language as to how thick the midsole are, the length, the shape, exact location, etc. of a midsole. The examiner believes that the specification as a whole lacks enablement for claiming a midsole. In the non-final Office action of April 21, 2011, the examiner also objected to the drawing that the subject matters of claims are not shown by the original drawings. That is, the correctness of the examiner's drawing objection, resting on the lack of clarity of the claimed the location of point 824 of midsole, is dependent on the correctness of the examiner's 35 USC 112 first paragraph rejection of claims based on the original specification. It is the policy of the USPTO in appropriate circumstances to decline to rule on a petitionable issue, when, as here, that an issue is also determinative of a rejection, and as such, is appropriate for consideration on appeal to the BPAI. In this case, the issue in the objection and rejection, as here, additionally and necessarily requires the exercise of technical skill and legal judgment in order to evaluate the facts presented, the issue is properly decided on the merits, and is properly reviewed on appeal, not petition. Under the circumstances, it is believed that the issues presented under the claim rejections and drawing objection in the instant case require the same review by the BPAI. Thus, this issue is appealable and should not be decided by petition.

### Conclusion

For the foregoing reasons, the relief requested by the petitioner will not be granted. Because there is both an objection to drawings under 37 CFR 1.83(a) and a rejection to claims under 35 USC 112, first paragraph, and both the correctness of the objection and the rejection depend on the same issue, the issue is an appealable one and will not be decided by petition.

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<sup>2</sup> The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification and drawings are confusing and inconsistent and therefore do not provide adequate basis to enable one of ordinary skill in the art to make the claimed shoe because it is not clear where the location of point 824 is to be located. The specification states "approximately 1/2 the length" however the drawings clearly show such a location to be in the forefoot of the footwear. One of ordinary skill in the art would not be able to determine which location is appropriate for the invention. Also the drawings do not show a midsole and one of ordinary skill in the art would not know what thickness, shape, exact location etc. would be appropriate. Therefore the specification lacks enablement for a midsole or the location of the point which the forward toe section of constant thickness of the insole meets the heel section of the insole with a decreasing thickness.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3765 awaiting a response to the outstanding Office action of April 21, 2011. Any request for reconsideration on or of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-3468.

PETITION DISMISSED

Angela D. Hayes for  
Donald T. Hajec, Director  
Technology Center 3700